



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,443	01/22/2002	Rebecca Klotzer	3568.076	7553

152 7590 09-12-2003

CHERNOFF, VILHAUER, MCCLUNG & STENZEL
1600 ODS TOWER
601 SW SECOND AVENUE
PORTLAND, OR 97204-3157

[REDACTED] EXAMINER

DEL SOLE, JOSEPH S

ART UNIT	PAPER NUMBER
1722	

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,443

Applicant(s)

KLOTZER, REBECCA

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 August 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 12-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 12-17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 09/642,390.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application (PCT/EP99/00286) under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. However, copendency has not been achieved. In order for copendency to be achieved the filing date of the parent application, 09/642,390, must be within 30 months of the filing of the parent application, DE19803361.1. 09/642,390 was filed on 8/18/2000, which is 30 months and 20 days after the filing of DE DE19803361.1. Since the filing date of 09/642,390 is more than 30 months past the priority date, PCT/EP99/00286 was abandoned before filing of the US case and copendency was not achieved.

Since copendency has not been achieved, the effective filing date of the present application is 8/18/2000. Therefore, publication DE19803362A1, which was published on 8/5/1999 is eligible as prior art under 35USC102(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Application/Control Number: 10/058,443

Art Unit: 1722

3. Claims 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Klotzer (DE19803362A1).

Klotzer teaches an apparatus having an extruder equipped with a metering apparatus and heating elements to form a polymer melt, the extruder having a cylinder connected via a first melt pump to a die for extrusion, an injection stage before the first melt pump, a heat exchanger located between the first melt pump and the die to form a second mixing stage, a second melt pump located upstream from the die; the heat exchanger is equipped with a mixer; the mixer is a static mixer; the injection stage has metering pumps that are connected via hollow needles and plates so as to be in fluid communication with the cylinder of the extruder; the metering pumps are equipped with coolable pump heads and the die is configured as a wide-slit nozzle.

Response to Arguments

4. Applicant's arguments filed 8/29, 2003 have been fully considered but they are not persuasive.

The Applicant argues that 35 USC 363 provides that the filing date of an International Application designating the United States is also the filing date of corresponding U.S. National application. The Applicant further argues that the proper filing date of parent application 09/642,390 was January 19, 1999.

The Examiner disagrees. 35 USC 363 provides that an international application designating the U.S. shall have the effect, from its international filing date, of a national application for patent regularly filed. Therefore, PCT/EP99/00286 has the effect of a national application, and thus is taken to have an effective U.S. filing date equal to its

Application/Control Number: 10/058,443

Art Unit: 1722

international filing date. However, the Applicant's statement that "the filing date... is also the filing date of corresponding U.S. National application" is not true in this instance. As discussed by the Examiner in the Office action of 8/12/03, the current application 10/058,443 fails to correspond properly as a continuing application of prior application PCT/EP99/00286 because 09/642,390 was not filed while PCT/EP99/00286 was still pending. In order to have the benefit of the filing date of PCT/EP99/00286, PCT/EP99/00286 would have had to have still been pending at the time that application 09/642,390 was filed. PCT/EP99/00286 was only pending for the period of 30 months after the filing of DE19803361.1 (filing date: 29 January 1998). Therefore, pendency of PCT/EP99/00286 ended 29 July 2000. Since 09/642,390 was filed 18 August 2000, it could not claim as its effective filing date the filing date of PCT/EP99/00286 and therefore the effective filing date of current application 10/058,443 is 18 August 2000. See MPEP 1895.01 II and 37CFR1.495(b).

The Applicant further argues that according to MPEP 1895.01 provides that a foreign priority claim is proper if (1) a claim for foreign priority was made in the international application, and (2) the foreign application was filed within 12 months prior to the international filing date.

These arguments are incomplete with regard to the Examiner's comments regarding priority and to the Examiner's explanation for the applicability of applying 35USC102(b) rejections. MPEP 1895.01 II states the full requirements, including that the continuing application (09/642,390) must be filed before the international application

Application/Control Number: 10/058,443

Art Unit: 1722

(PCT/EP99/00286) becomes abandoned as to the U.S as set forth in 37 CFR 1.495. 37

CFR 1.495 (b) states:

To avoid abandonment of the application, the Applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the Internationally Bureau or unless it was originally filed in the United Stated Patent and Trademark Office; and

(2) The basic national fee (see 1.492(a)).

Therefore, the international application was abandoned and the effective filing date of applications 09/642,390 and 10/058,443 stands as 18 August 2000. The Examiner notes that the Applicant has not argued this issue of a lack of copendency between 09/642,390 and PCT/EP99/00286.

The Applicant further discusses the relationship between PCT/EP99/00286 and DE19803362.1. This point is moot, since the issue at hand is the relationship and lack of copendency between 09/642,390 and PCT/EP99/00286.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1722

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Del Sole whose telephone number is (703) 308-6295. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Joseph S. Del Sole
J.S.D.
September 8, 2003

Robert Davis
ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300 1722

9/11/03